

## **REMARKS**

### **I. Introduction**

Claims 1 to 10 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Rejection of Claims 1, 2 and 10 Under 35 U.S.C. § 102(b)**

Claims 1, 2 and 10 were rejected under 35U.S.C. § 102(b) as anticipated by U.S. Patent No. 2,883,020 ("Kuemmich et al."). It is respectfully submitted that Kuemmich et al. do not anticipate claims 1, 2 and 10 for the following reasons.

Claim 1 relates to a parking lock mechanism for an automotive transmission by which a transmission shaft mounted with roller bearings is lockable with respect to a transmission housing. Claim 1 recites that the parking lock mechanism includes a roller bearing outer race, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft. Claim 1, as amended herein without prejudice, further recites that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with the roller bearing outer race. Support for the amendment to claim 1 may be found, for example, in Figure 1.

Claim 10 relates to a parking lock mechanism for an automotive transmission by which a transmission shaft mounted with roller bearings is lockable with respect to a transmission housing. Claim 10 recites that the parking lock mechanism includes a roller bearing outer race, a means for connecting the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing, and an axially displaceable body connectable in a rotationally fixed manner to the transmission shaft. Claim 10, as amended herein without prejudice, further recites that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with the roller bearing outer race. Support for the amendment to claim 10 may be found, for example, in Figure 1.

Kuemmich et al. purportedly relate to a shifting device for claw clutches. The shifting device is stated to include a main shaft 10 supported by bearings 8 and 9 in a housing 11. Col. 2, lines 11 to 15. Hub 22 is stated to be fastened to housing 11 by screws 21. Col. 2, lines 26 to 27. Element 16 is stated to be provided with claws 19 which can be brought into engagement with counter claws 20 of hub 22. Col. 2, lines 24 to 26.

Nowhere, however, do Kuemmich et al. disclose, or even suggest, that an axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with a roller bearing outer race, as recited in claims 1 and 10, as amended herein without prejudice. According to the present application, a direct connection using pins is possible between the axially displaceable body and the roller bearing outer race without any manufacturing-related tolerance problems provided that materials are chosen for the transmission housing allowing the material to yield within certain limits. In this regard, the Specification of the present application states the following:

[A] high torque transmission capability of the roller bearing outer race to the transmission housing is achieved through multiple pins. The use of multiple pins is possible without any manufacturing-related tolerance problems because using a lightweight cast metal for the transmission housing allows the material to yield within certain limits. This gives a uniform distribution of torque among the individual pins the first time a load is applied to the parking lock mechanism.

See page 3, line 15 to 23. As indicated above, element 16 of Kuemmich et al. is stated to be provided with claws 19 which can be brought into engagement with counter claws 20 of hub 22. See col. 2, lines 24 to 26. Accordingly, claws 19 directly engage hub 22 not bearing outer race 9, and thus are not lockable and rotationally fixed directly with bearing outer race, as recited in amended claims 1 and 10. Therefore, Applicant respectfully submits that Kuemmich et al. do not disclose all of the limitations of claims 1 and 10.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Kuemmich et al. do not disclose, or even suggest, that an axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with a roller bearing outer race, as recited in amended claims 1 and 10. Therefore, it is respectfully submitted that Kuemmich et al. do not anticipate claims 1 and 10.

As for claim 2, which depends from claim 1 and therefore includes all of the limitations of claim 1, Applicant respectfully submits that Kuemmich et al. do not anticipate

dependent claim 2 for at least the reasons provided above in support of the patentability of claim 1.

### **III. Rejection of Claims 6 and 9 Under 35 U.S.C. § 102 (b)**

Claims 6 and 9 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,073,502 (“Wallace”). It is respectfully submitted that Wallace does not anticipate claims 6 and 9 for the following reasons.

Claim 6 relates to a roller bearing outer race. Claim 6 recites that the roller bearing outer race includes gearing engageable with a corresponding gearing and includes an arrangement configured for form-fitting torque transmission to a transmission housing. Claim 6, as amended herein without prejudice, further recites that the gearing of the roller bearing outer race is arranged on an end face of the roller bearing outer race.

Claim 9 relates to a roller bearing outer race. Claim 9, as amended herein without prejudice, recites that the roller bearing outer race includes means for form-fitting torque transmission to a transmission housing and a gearing arranged on an end face of the roller bearing outer race engageable with a corresponding gearing.

Wallace purportedly relates to a power takeoff device. Customer gear bank 69 is stated to be in meshed engagement with transmission gear 45 and input ratio gear bank 71 is stated to be meshed with gear teeth 81 in cluster output gear 83. See col. 6, lines 19 to 23. Transmission gear 45 is stated to be connected to shaft 43 and gear teeth 8 are stated to be connected to shaft 29. See col. 5, lines 24 to 26 and col. 6, lines 23 to 27. Input ratio gear bank 71 is stated to rotate about shaft 47 via bearings 73 and cluster output gear 83 is stated to be fixed to rotatable output shaft 29. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29.

The Office Action alleges that Wallace discloses an arrangement configured or a means for form-fitting torque transmission to a housing. See Office Action at p. 3. Respectfully, torque transmitted from gear bank 71 to output gear 83 is not transmitted to housing 31 because output shaft 29 is rotatable and idler shaft 47 is rotatably supported via bearings 73. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29. Accordingly, any torque transmission is to the gears and not to the housing. Therefore, Wallace does not disclose, or even suggest, a roller bearing outer race including an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in claim 6, nor a roller bearing outer race including means for form-fitting torque transmission to a transmission housing, as recited in claim 9.

The Office Action further alleges that the housing itself qualifies as a means for or an arrangement configured for form fitting torque transmission to a housing. Respectfully, this allegation is made out of context. Claims 6 and 9 recite a roller bearing outer race, which includes, *inter alia*, gearing arranged on an end face of the roller bearing outer race. Respectfully, the housing itself does not qualify as a part of the outer bearing race. A separate outer bearing race not part of housing 31 and not including a gearing arranged on an end face, directly above bearing 53, for example, is illustrated in Figure 1.

The assertion at page 5 of the Office Action that “a housing . . . can be configured for form fitting torque transmission to a housing” makes plain that Kuemmich et al. do not anticipate the subject matter claimed since a finding of anticipation can only be based on a reference that discloses the identical arrangement as claimed.

The Office Action further alleges that elements 67 and 71 qualify as the gearing arranged on a face of the roller bearing outer race and the corresponding gear, as recited in claims 6 and 9. However, claims 6 and 9, as amended herein without prejudice, recite that the gearing is arranged on an end face of the roller bearing outer race. Respectfully, neither element 67 nor element 71 are arranged on an end face of a gearing. Accordingly, Wallace does not disclose all of the limitations of claims 6 and 9, as amended herein, and, therefore, does not anticipate claims 6 and 9.

#### **IV. Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)**

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kuemmich et al. and U.S. Patent No. 5,800,072 (“Buch et al.”). Applicant respectfully submits that the combination of Kuemmich et al. and Buch et al. does not render unpatentable claims 3 and 4 for the following reasons.

Claims 3 and 4 ultimately depend from claim 1. As indicated above, Kuemmich et al. do not disclose all of the limitations of claim 1. Nor do Buch et al. cure the deficiencies of Kuemmich et al. More specifically, the combination of Kuemmich et al. and Buch et al. does not disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing or that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with the roller bearing outer race, as recited in claim 1. Therefore, the combination of Kuemmich et al. and Buch et al. does not disclose all of the limitations of claims 3 and 4, which ultimately depend from claim 1.

In rejecting a claim under 35 U.S.C. § 103 (a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, the combination of Kuemmich et al. and Buch et al. fails to disclose, or even suggest, each and every feature of claim 1, from which claims 3 and 4 ultimately depend. It is therefore respectfully submitted that the combination of Kuemmich et al. and Buch et al. does not render obvious claims 3 and 4, which ultimately depend from claim 1.

#### V. Rejection of Claim 5 Under 35 U.S.C. § 103(a)

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kuemmich et al., Buch et al. and U.S. Patent No. 4,782,719 (“Yarnell”). Applicant respectfully submits that the combination of Kuemmich et al., Buch et al. and Yarnell does not render unpatentable claim 5 for the following reasons.

Claim 5 ultimately depends from claim 1 and further recites that the arrangement includes a pin connection including multiple pins configured to form-fittingly and rotationally fixedly connect the roller bearing outer race with the transmission housing. Claim 5 further recites that the transmission housing includes a light metal cast part.

As indicated above, Kuemmich et al. do not disclose all of the limitations of claim 1. Nor do Buch et al. or Yarnell cure the deficiencies of Kuemmich et al. More specifically, the combination of Kuemmich et al., Buch et al. and Yarnell does not disclose, or even suggest, an arrangement configured to connect the roller bearing outer race in a form-fitting, rotationally fixed manner to the transmission housing or that the axially displaceable body is lockable in a form-fitting and rotationally fixed manner directly with the roller bearing outer race, as recited in claim 1. Therefore, the combination of Kuemmich et al., Buch et al. and Yarnell does not disclose all of the limitations of claim 5, which ultimately

depends from claim 1. In view of the foregoing, it is respectfully submitted that the combination of Kuemmich et al., Buch et al. and Yarnell does not render obvious claim 5.

Furthermore, the Office Action's allegation that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine Kuemmich et al., Buch et al. and Yarnell for the purpose of reducing weight is completely unsupported and is apparently improperly based on Applicant's own application. Specifically, the Specification states the following:

The use of multiple pins is possible without any manufacturing-related tolerance problems because using a lightweight cast metal for the transmission housing allows the material to yield within certain limits. This gives a uniform distribution of torque among the individual pins the first time a load is applied to the parking lock mechanism.

See page 3, line 15 to 23. None of the patents or publications relied upon mention or refer to the motivation alleged in the Office Action for making the proposed combination.

The apparent reliance on Applicant's Specification makes plain that the present rejection is based on nothing more than impermissible hindsight. *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999) (combining prior art references without evidence of a suggestion, teaching, or motivation to make the combination simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight).

#### **VI. Rejection of Claims 7 and 8 Under 35 U.S.C. § 103(a)**

Claims 7 and 8 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Wallace and Buch et al. Applicant respectfully submits that the combination of Wallace and Buch et al. does not render unpatentable claims 7 and 8 for the following reasons.

Claims 7 and 8 ultimately depend from claim 6. Applicant respectfully submits that the combination of Wallace and Buch et al. does not disclose all of the limitations of claim 6, from which claims 7 and 8 ultimately depend. Specifically, the combination of Wallace and Buch et al. does not disclose, or even suggest, an arrangement configured for form-fitting torque transmission to a transmission housing, as recited in claim 6. As indicated above, torque transmitted from gear bank 71 to output gear 83 is not transmitted to housing 31 because output shaft 29 is rotatable and idler shaft 47 is rotatably supported via bearings 73. See col. 5, lines 44 to 48 and col. 6, lines 19 to 29. Further, the

combination of Wallace and Buch et al. does not disclose, or even suggest, gearing arranged on an end face of the roller bearing outer race, as recited in claim 6. Accordingly, the combination of Wallace and Buch et al. does not disclose all of the limitations of claims 7 and 8 and, therefore, does not render obvious claims 7 and 8.

**VII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated:

April 13, 2004

By:

Richard L. Mayer  
Reg. No. 22,490  
*R-L Mayer by Chihlin*  
*Reg. No. 42,194*

One Broadway  
New York, New York 10004  
(212) 425-7200

**CUSTOMER NO. 26646**